



# UNITED STATES PATENT AND TRADEMARK OFFICE

79  
UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,407	11/12/2003	George H. Forman	200300822-1	6790
22879 7590 12/29/2006 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			EXAMINER LY, CHEYNE D	
			ART UNIT 2168	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			12/29/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/706,407

Applicant(s)

FORMAN ET AL.

Examiner

Cheyne D. Ly

Art Unit

2168

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/12/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

### **DETAILED ACTION**

1. Claims 1-36 are examined on the merits.

### **OBJECTIONS**

2. Claim 7 is objected to because of the term "to" is in quotation marks. Appropriate correction is required.

### **CLAIM REJECTIONS - 35 U.S.C. § 112, SECOND PARAGRAPH**

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claims 1, 3, 18, 20, 23, 25, 28, and 33 provide for the use of "the auxiliary criterion" or "a processor", but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Claims 2, 4-17, 19, 21, 22, 24, 26, 27, 29-32, and 34-36 are rejected for being dependent from the above rejection claims.

### **CLAIM REJECTIONS - 35 USC § 101**

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
8. Claims 1-36 are rejected because said claims do not result in a physical transformation, or produce a useful, tangible, and concrete result. For example, Claim 1 recites the limitation of “using...to identify the email address.” However, the mere recitation of “using...” does not support that invention result in a physical transformation, or produce a useful, tangible, and concrete result. Further, the limitation “using...” causes the claims to be unclear as to whether a result is generated; therefore, not useful, tangible, and, especially, concrete result is realized by practicing the claimed invention.
9. In regard to claims 28 and 29, the specification [51] describes a “computer-readable medium...an electronic, magnetic, optical, electromagnetic, infared...” Therefore, a reasonable interpretation is said claims embody nonstatutory subject matter such as signals or carrier waves which are not suitable media under 35 U.S.C. 101.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

11. Claims 1-14 and 18-36 are rejected under 35 U.S.C. 102(a) as being anticipated by Henry (US 2003/0200265 A1).

12. In regard to claim 1, Henry discloses a processor-based method for selecting an email address, wherein the email address includes a format, the processor-based method comprising:  
  
Defining at least one auxiliary criterion, wherein the auxiliary criterion uses information in addition to information in an email associated with the email address (pages 4-5, [0037], especially, “key in a name, a...(URL), a company or organization name...”); and  
  
Using the auxiliary criterion to identify the email address (pages 4-5, [0037], especially, “Third party email search module...one or more addresses...”).
13. In regard to claims 2 and 3, Henry discloses accepting a signal from a user input device to at least partially define the at least one auxiliary criterion (pages 4-5, [0037], especially, “key in a name, a...(URL), a company or organization name...”).
14. In regard to claims 4, 5, and 6, Henry discloses the identified email is part of a search request (pages 4-5, [0037], especially, “key in a name, a...(URL), a company or organization name...Third party email search module...one or more addresses (group)...”).
15. In regard to claim 7, Henry discloses recording an indication of the determined group in a “to” line in an email message header (claim 6, especially, “transmitting said message...to the email address”). It is inherent in the disclosure the destination email is in the header.
16. In regard to claims 8-11, Henry discloses the step of defining is performed by a local processor (page 2, [0020]-[0022]) coupled to an external database remote (Figure 3, Item 300) from the local processor, wherein the auxiliary criterion is used to access information in the external database (pages 4-5, [0037], especially, “key in a name,

a...(URL), a company or organization name...Third party email search module...one or more addresses (group)...”, and [0038]). The limitation of external database is inherent in the disclosure for the third party email service using LDAP (page 3, [0028]). For example, Michael Donnelly, cited as a secondary reference to support inherency, describes LDAP as a type of database (page 2, lines 2-3).

17. In regard to claims 12-14, Henry discloses the auxiliary criterion being a manager's name (page 4, [0037], especially, “a name”), a department name (Figure 4, Item 404, College Department), and company division name (page 4, [0037], especially, “company name”).
18. In regard to claims 18-33 and 36 Henry discloses the claimed invention as cited above.
19. In regard to claim 34, Henry discloses indicating email messages, from the group of email messages, that meet the auxiliary criterion (page 4, [0034], especially, “the email validation is positive, an email message screen 412 is displayed...”).
20. In regard to claim 35, Henry discloses generating a display of email messages; and wherein at least one of the group of email messages are omitted from the display of email messages (page 4, [0034], especially, “the email validation is positive, an email message screen 412 is displayed...” and [0037]). It has been interpreted that the email messages are displayed when the validation is positive and not displayed when invalid.

### ***Claim Rejections - 35 USC § 103***

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
23. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henry (US 2003/0200265 A1) as applied to claims 1-14 and 18-36.

#### **MOTIVATION**

24. Henry discloses an improvement to address the need to minimize misdirected email due to the specification of an invalid email address (page 1, [0004]). Further, the system of Henry prompts the user to input a variety of information about the intended recipient of a transmission. For instance, the user may key in a name, a...(URL)..." Therefore, it would have been obvious to one of ordinary skill in the art at the time of the instant invention to improve the disclosure of Henry to include a variety of information beyond those exemplified by Henry to minimize misdirected email due to the specification of an invalid email address.

#### **PRIOR ART**

25. In regard to claims 15-17, Henry does not specify that the information being an identification of a project, an identification of a meeting, or a geographic location.

However, it would have been obvious to one of ordinary skill in the art to improve the disclosure of Henry to include a variety of information such as an identification of a project, an identification of a meeting, or a geographic location to minimize misdirected email due to the specification of an invalid email address.

### **CONCLUSION**

26. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.
27. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199. The USPTO's official fax number is 571-272-8300.



Art Unit: 2168

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (571) 272-0716.

The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

29. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo, can be reached on (571) 272-3642.

C. Dune Ly  
Patent Examiner  
12/23/06

